

Application No.: 10/508,942
Filing Date: October 01, 2004

AMENDMENTS TO THE DRAWINGS

Please amend the original "FIG. 10" to "FIG. 11."

Please add new FIG. 10 in place of the original FIG. 10.

A "Replacement Sheet" for each sheet of drawings being amended can be found in the Appendix. In addition, a "New Sheet" for each sheet of drawings being added can be found in the Appendix. Also, for the Examiner's reference, accompanied are the marked-up drawings showing the above-described amendments and addition.

REMARKS

This paper is in response to the Office Action dated November 26, 2007. Applicant has amended the application as set forth above. Specifically, Applicant has amended Claims 1-13 and added new Claims 14-17. Applicant has also amended FIG. 10 to FIG. 11, and added new FIG. 10. In addition, Applicant has amended the abstract. No new matter is added by the amendments as discussed below. Applicant respectfully requests the entry of the amendments and reconsideration of the application in view of the above amendments and the following remarks.

Discussion of Amendments to Claims

The amendments to Claims 1-13 have been made to clarify the steps set forth therein. In addition, new Claims 14-17 have been added. To provide an explanation of the support in the patent disclosure for the claim amendments and additions presented above, Applicant provides the following table for the Examiner's convenience. The table provides references to example paragraphs, figures, or claims in U.S. Patent Application Publication No. 2005/0177493 that support the listed claims. In some cases, other passages may provide additional support for the listed claim elements.

Claim	Paragraph No. of 2005/0177493	Figure No. of 2005/0177493	Claim No. of 2005/0177493
1	0049-0052	5	1
2	0062-0066		2
3	0048		3
4	0048		4
5	0054		5
6	0044 and 0062		6
7	0060-0061	9	7
8	0060-0061	9	8
9	0062, 0063, and 0066		9
10	0040 and 0049-0052	2	10

11	0048		11
12	0054		12
13	0044 and 0062		13
14	0050 and 0051		
15	0050 and 0051		
16	0050 and 0051		
17	0017 and 0068	1	

As such, Applicant respectfully submits that the amendments and the new claims are fully supported by the application as originally filed and do not constitute the addition of new matter. Thus, Applicant respectfully requests the entry of the amendments.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Discussion of Objection to Drawings and Amendments to Drawings

The Examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(5) because they do not include reference numbers 200, 210, and 220 mentioned in the description.

In response, Applicant has amended the original FIG. 10 to be FIG. 11, and added a new FIG. 10. Support for the amendments to the original FIG. 10 can be found in the specification, for example, at paragraphs 0028 and 0070-0072 of Patent Application Publication No.

2005/0177493. Support for the addition of the new FIG. 10 can be found in the specification, for example, at paragraphs 0027, 0063, 0064, and 0066. Particularly, each step of the new FIG. 10 is fully supported by description at paragraph 0064 of the Publication. As such, Applicant respectfully submits that the amendments to the original FIG. 10 and the addition of the new FIG. 10 are fully supported by the application as originally filed and do not constitute the addition of new matter. As such, Applicant respectfully requests the entry of the amendment and addition.

The new FIG. 10 illustrates a flow chart including steps S200, S210, and S220 which are mentioned in the description at paragraph 0064 of the Publication. Thus, the drawings now comply with 37 CFR 1.84(p)(5). As such, Applicant respectfully requests the withdrawal of the objection to the drawings.

Discussion of Amendments to the Specification and Objection to the Specification

The Examiner objected to the abstract of the disclosure because the abstract includes a self-evident clause "Disclosed are..."

Applicant respectfully disagrees with the Examiner. However, solely to advance the prosecution of this application, Applicant has amended the Abstract as set forth above, and respectfully submits that the Abstract does not include a self-evident clause. As such, the Abstract fully complies with the MPEP § 608.01(b). Thus, Applicant respectfully requests the withdrawal of the objection.

Discussion of Rejection of Claims 1-3 and 6 Under 35 U.S.C. § 102 based on U.S. Patent No. 6,193,155

The Examiner rejected Claims 1-3 and 6 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 6,193,155 to Walker et al., hereinafter "Walker '155." Applicant respectfully disagrees with the Examiner and submits that Walker '155 does not anticipate Claims 1-3 and 6, as discussed below.

The Law of Anticipation

Anticipation under Section 102 can be found only if a reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985). More particularly, a finding of anticipation requires the disclosure in a single piece of prior art of each and every

limitation of a claimed invention. *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994).

Disclosure of Walker '155

Walker '155 discloses methods and apparatus for issuing and processing gift certificates which can be issued and redeemed in conjunction with credit card accounts. See Walker '155, column 1, lines 25-29. In the methods and apparatus of Walker '155, a credit card issuer (e.g., a credit card company) 102 issues a gift certificate associated with an existing credit card account of a credit card holder 104. See *id.* at Figure 1; column 5, lines 5-25. The gift certificate is assigned a certificate identifier for identifying the certificate and the associated credit card account. For the Examiner's convenience, Figure 1 of Walker '155 is reproduced below.

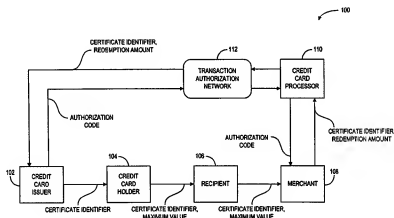


FIG. 1

The credit card holder 104 transfers the gift certificate to a recipient 106. See id. at Figure 1; column 5, lines 26-30. The recipient 106 (the gift card holder, but not the credit card holder) can redeem the gift certificate by presenting it to a merchant 108 for purchasing goods and/or services. See id. at Figure 1; column 5, lines 26-37.

The merchant 108 sends the certificate identifier and a redemption amount to a credit card processor 110 for approval. See *id.* at Figure 1; column 5, lines 38-47. Upon receiving the certificate identifier and a redemption amount, the credit card issuer 102 determines whether to authorize the redemption of the gift certificate based on the authenticity of the certificate identifier and the available credit of the credit card account of the credit card holder 104. See *id.* at Figure 1;

column 5, lines 38-59. Then, the account data of the credit card account is updated to reflect the redemption of the identified gift card. *See id.* at column 4, lines 4-6.

In summary, Walker '155 discloses methods and apparatus in which *a gift certificate giver (who is also a credit card holder) 104 gives a recipient 106 a gift certificate that is associated with and redeemed from the giver's credit card account, not the recipient's account.* Also, the gift certificate recipient 106 needs to present *the gift certificate to a merchant* for redemption.

Summary of the Present Invention

For the Examiner's better understanding of the current claims, Applicant hereby briefly explains the basic scheme to which the claimed methods and system can apply. Although the following describes the general scheme of the invention, the individual claims may deviate from the description. Also, the pending claims may cover only selected steps or aspects of the scheme set forth below.

In the methods and systems of the present invention, a gift certificate giver who has purchased a gift certificate transfers the gift certificate to a gift certificate recipient. The gift certificate recipient then registers the gift certificate with his/her own financial account (e.g., a credit card account or bank account). By this registration process, the gift certificate receiver associates the gift certificate with the recipient's own financial account. By this process, the gift certificate's monetary value is placed on the recipient's account. This is performed by either increasing a limit (either credit limit or available credit) or a balance on the financial account. The gift certificate recipient, when purchasing goods and/or services, can use his own credit card or debit card with the increased limit or balance. Thus, contrary to Walker '155, the gift certificate is not to be associated with the gift certificate giver's credit card account for redemption therefrom, and the gift certificate recipient does not need to present the received gift certificate to a merchant for redemption.

Walker '155 Does Not Anticipate Claim 1

Claim 1 is directed to a method for processing a gift certificate. The method includes the steps of receiving, by a financial institution, information identifying a financial account of the financial institution, wherein the financial account has a predetermined limit. The method further includes *receiving, by the financial institution, a request for increasing the limit of the financial account based on a gift certificate which has a monetary value.* The method also

includes *increasing the limit of the financial account by the monetary value by the financial institution*.

Among many features of Claim 1, Walker '155 does not teach “*receiving, by the financial institution, a request for increasing the limit of the financial account based on a gift certificate*” which has a monetary value” as recited in Claim 1. Walker '155 also fails to teach “*increasing the limit of the financial account by the monetary value by the financial institution*” as recited in Claim 1. As such, Walker '155 does not teach every element and limitation of the Claim 1. Therefore, Walker '155 does not anticipate Claim 1.

Walker '155 Does Not Anticipate Claim 2

Claim 2 is directed to a method of a method for processing gift certificate. The method comprises the steps of: receiving, by a financial institution, information identifying a financial account of the financial institution, wherein the financial account has a balance. The method also includes *receiving, by the financial institution, a request for increasing the balance of the financial account based on a gift certificate* which has a monetary value. The method further includes *adding the monetary value of the gift certificate to the balance of the financial account by the financial institution*.

Among features of Claim 2, Walker '155 does not teach a step of *receiving, by the financial institution, a request for increasing the balance of the financial account based on a gift certificate* which has a monetary value; and a step of *adding the monetary value of the gift certificate to the balance of the financial account by the financial institution*. As such, Walker '155 does not teach every element and limitation of the Claim 2. Therefore, Walker '155 does not anticipate Claim 2.

Walker '155 Does Not Anticipate Claims 3 and 6

Claims 3 and 6 depend directly from Claim 1, and define additional technical features. Thus, Walker '155 does not anticipate these claims.

Discussion of Rejection of Claim 10 Under 35 U.S.C. § 102 based on U.S. Patent No. 6,330,544

The Examiner rejected Claim 10 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 6,330,544 to Walker et al., hereinafter “Walker '544.” Applicant respectfully disagrees with the Examiner and submits that Walker '544 does not anticipate Claim 10, as discussed below.

Disclosure of Walker '544

For the Examiner's reference, Walker '544 is a divisional of application No. 08/858,738, and Walker '155 is a continuation-in-part of application No. 08/858,738. Thus, Walker '544 provides disclosures similar to Walker '155.

Walker '544 discloses a redemption voucher processing system 100. Walker '544, column 7, lines 6-32. Similar to Walker '155, in Walker '544, *a redemption voucher (e.g., a gift certificate) giver 104 (who is also a credit card holder) transfers a voucher associated with and redeemable from the giver's own credit card account* to a voucher recipient 106. *See id.* at Figure 1; column 8, lines 42-67; and column 9, lines 12-19. The voucher recipient 106 presents *the voucher to a merchant* for redemption. *See id.* at Figure 1; and column 9, lines 19-40.

Walker '544 Does Not Anticipate Claim 10

Claim 10 is directed to a system for making a transaction with a financial institution. Claim 10 recites an input module configured to receive information identifying a financial account of the financial institution, wherein the financial account has a predetermined limit, and further to *receive a request for increasing the limit of the financial account based on a gift certificate which has a monetary value*. Claim 10 also recites an account processing module configured to *increase the limit of the financial account by the monetary value in response to the request*.

Among the features of Claim 10, Walker '544 does not teach a module configured to *receive a request for increasing the limit of the financial account based on a gift certificate which has a monetary value*. Walker '544 also fails to disclose a module configured to *increase the limit of the financial account by the monetary value in response to the request*. As such, Walker '544 does not teach every element and limitation of the Claim 10. Therefore, Walker '544 does not anticipate Claim 10.

Discussion of Rejection of Claim 4 under 35 U.S.C. § 103

The Examiner rejected Claim 4 under 35 U.S.C. § 103 (a) as being unpatentable over Walker '155 in view of U.S. Patent No. 6,006,205 to Loeb et al., hereinafter "Loeb." Applicant respectfully submits that Claims 4 is patentable over the reference as discussed below.

Standard for Obviousness Rejection

The Patent and Trademark Office has the burden under section 103 to establish a *prima facie* case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-87 (Fed. Cir. 1984). To establish a *prima facie* case of obviousness, however, prior art (as opposed to prior art references) must teach or suggest all the claim limitations. "Examination Guidelines for Determining Obviousness Under 35 U.S.C. §103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*" Federal Register Vol. 72 No. 195 at 57528 (October 10, 2007). Further, the Patent Office must explain why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. *Id.*

Disclosure of Loeb

Loeb discloses a billing system which facilitates the placement of charges for goods or services on a credit card billing statement. Loeb, column 1, lines 5-12. Loeb is relied on as teaching that a test is performed by a credit card issuer to determine if the credit card number is valid and if the purchase amount is within the available credit limit. *Id.* at column 11, lines 38-41.

No Prima Facie Case of Obviousness Has Been Established Against Claim 4

Since Claim 4 depends from Claim 1, if Claim 1 is patentable, Claim 4 is also patentable. Thus, now the patentability of Claim 1 is discussed. Claim 1 is patentable over Walker '155 in view of Loeb, as set forth below.

As discussed above in connection with the rejection of Claim 1 under §102, Walker '155 fails to teach, among features of Claim 1, "*receiving, by the financial institution, a request for increasing the limit of the financial account based on a gift certificate*" which has a monetary value" as recited in Claim 1. Walker '155 also fails to teach "*increasing the limit of the financial account by the monetary value by the financial institution*" as recited in Claim 1.

Loeb does not cure the deficiencies of Walker '155. Applicant submits that Loeb also fails to disclose any step equivalent to the steps of Claim 1 set forth above.

Furthermore, it would not have been obvious to one of ordinary skill in the art to provide the steps of Claim 1 in view of the combined teachings of Walker '155 and Loeb. In Walker '155's methods and apparatus, a gift certificate redeemable from a credit card account of a credit card holder 104 (a gift certificate giver), and is given to a gift certificate recipient 106. Upon redemption of the gift certificate by the recipient 106, funds will be drawn from the credit card account to back the gift certificate. *See* Walker '155, column 7, lines 11-12.

Under this scheme, the credit card issuer 102 of the credit card account would not increase a limit (e.g., credit limit or available credit) of the credit card account. One of ordinary skill in the art would rather decrease the limit in view of the existence of the gift certificate such that the gift certificate can be fully backed by the credit card account. Therefore, it would not have been obvious to one of ordinary to increase the limit of a financial account based on a gift certificate, as recited in Claim 1. Thus, Claim 1 and its dependent claims including Claim 4 are patentable over Walker '155 and Loeb.

Discussion of Rejection of Claims 5 and 8 under 35 U.S.C. § 103

The Examiner rejected Claims 5 and 8 under 35 U.S.C. § 103 (a) as being unpatentable over Walker '155 in view of Bookstore Manager Software Reference Manual Vs. 6.00, hereinafter "Manual." Applicant respectfully submits that Claims 5 and 8 are patentable over the reference as discussed below.

Disclosure of Manual

Manual discloses that if a gift certificate is for less than the "payment amount" due on the current POS transaction, the remaining "payment amount" will be shown..

No Prima Facie Case of Obviousness Has Been Established Against Claims 5 and 8

Since Claims 5 and 8 depend from Claim 1, if Claim 1 is patentable, Claims 5 and 8 are also patentable. Thus, now the patentability of Claim 1 is discussed. Claim 1 is patentable over Walker '155 in view of Manual as discussed below.

As discussed above in connection with the rejection of Claim 1 under §102, Walker '155 fails to teach, among other features of Claim 1, *"receiving, by the financial institution, a request for increasing the limit of the financial account based on a gift certificate* which has a monetary value" as recited in Claim 1. Walker '155 also fails to teach *"increasing the limit of the financial account by the monetary value by the financial institution"* as recited in Claim 1.

Manual does not cure the deficiencies of Walker '155. Applicant submits that Manual also fails to disclose any step equivalent to the steps of Claim 1 set forth above.

Furthermore, it would not have been obvious to one of ordinary skill in the art to provide the steps of Claim 1 in view of the combined teachings of Walker '155 and Manual, as set forth above with respect to Rejection of Claim 4. Thus, Claim 1 and its dependent claims including

Claims 5 and 8 are patentable over Walker '155 and Manual.

Discussion of Rejection of Claim 7 under 35 U.S.C. § 103

The Examiner rejected Claim 5 under 35 U.S.C. § 103 (a) as being unpatentable over Walker '155 in view of the Sunshine Support Services MMS Receipt Printer Example, hereinafter "Sunshine." Applicant respectfully submits that Claims 7 is patentable over the reference as discussed below.

Disclosure of Sunshine

Sunshine discloses sales classifications on a receipt sample.

No Prima Facie Case of Obviousness Has Been Established Against Claim 7

Since Claim 7 depends from Claim 1, if Claim 1 is patentable, Claim 7 is also patentable. Thus, now the patentability of Claim 1 is discussed. Claim 1 is patentable over Walker '155 in view of Sunshine as discussed below.

As discussed above in connection with the rejection of Claim 1 under §102, Walker '155 fails to teach, among other features of Claim 1, *"receiving, by the financial institution, a request for increasing the limit of the financial account based on a gift certificate which has a monetary value"* as recited in Claim 1. Walker '155 also fails to teach *"increasing the limit of the financial account by the monetary value by the financial institution"* as recited in Claim 1.

Sunshine does not cure the deficiencies of Walker '155. Applicant submits that Sunshine also fails to disclose any step equivalent to the steps of Claim 1 set forth above.

Furthermore, it would not have been obvious to one of ordinary skill in the art to provide the steps of Claim 1 in view of the combined teachings of Walker '155 and Sunshine, as set forth above with respect to Rejection of Claim 4. Thus, Claim 1 and its dependent claims including Claim 7 are patentable over Walker '155 and Sunshine.

Discussion of Rejection of Claim 9 under 35 U.S.C. § 103

The Examiner rejected Claim 9 under 35 U.S.C. § 103 (a) as being unpatentable over Walker '155 in view of the Lamiell: ONLINE BILL-PAYING ON THE MEMU FOR EARLY '98 CHASE MANHATTAN WILL BECOME FIRST U.S. BANK TO OFFER SERVICE, hereinafter "Lamiell." Applicant respectfully submits that Claims 9 is patentable over the reference as

discussed below.

Disclosure of Lamiell

Lamiell discloses that Chase Manhattan Corp. will become the first U.S. bank to allow customers to look at and pay bills directly over the Internet.

No Prima Facie Case of Obviousness Has Been Established Against Claim 9

Since Claim 9 depends from Claim 2, if Claim 2 is patentable, Claim 9 is also patentable. Thus, now the patentability of Claim 2 is discussed. Claim 2 is patentable over Walker '155 in view of Lamiell as set forth below.

As discussed above in connection with the rejection of Claim 2 under §102, Walker '155 fails to teach, among other features of Claim 2, a step of *receiving, by the financial institution, a request for increasing the balance of the financial account based on a gift certificate* which has a monetary value; and a step of *adding the monetary value of the gift certificate to the balance of the financial account by the financial institution*.

Lamiell does not cure the deficiencies of Walker '155. Applicant submits that Lamiell also fails to disclose any step equivalent to the above steps of Claim 2.

Furthermore, it would not have been obvious to one of ordinary skill in the art to provide the step of Claim 2 in view of the combined teachings of Walker '155 and Lamiell. In Walker '155's methods and apparatus, a gift certificate is drawn on a credit card account of a gift certificate giver, and is given to a gift certificate recipient. Upon redemption of the gift certificate by the recipient, funds will be drawn from the credit card account to back the gift certificate. See Walker '155, column 7, 11-12.

Under this scheme, the credit card issuer of the credit card account would not add the monetary value of the gift certificate to the credit card account. Such addition of monetary value would increase available credit on the credit card account. One of ordinary skill in the art would rather decrease the available credit of the credit card account in view of the gift certificate such that the gift certificate is fully backed by the credit card account. Therefore, it would not have been obvious to one of ordinary to *add the monetary value of the gift certificate to the balance of the financial account by the financial institution*, as recited in Claim 2. Thus, Claim 2 and its dependent claims including Claim 9 are patentable over Walker '155 and Lamiell.

Discussion of Rejection of Claims 11 and 13 under 35 U.S.C. § 103

The Examiner rejected Claims 11 and 13 under 35 U.S.C. § 103 (a) as being unpatentable over Walker '155 in view of Walker '544. Applicant respectfully submits that Claims 11 and 13 are patentable over the reference as discussed below.

No Prima Facie Case of Obviousness Has Been Established Against Claim 11

Since Claims 11 and 13 depend from Claim 10, if Claim 10 is patentable, Claims 11 and 13 are also patentable. Thus, now the patentability of Claim 10 is discussed. Claim 10 is patentable over Walker '544 in view of Walker '155 as discussed below.

As discussed above in connection with the rejection of Claim 10 under §102, Walker '544 fails to teach, among other features of Claim 10, an input module configured to *receive a request for increasing the limit of the financial account based on a gift certificate which has a monetary value*. Walker '544 also fails to disclose an account processing module configured to *increase the limit of the financial account by the monetary value in response to the request*.

Walker '155 does not cure the deficiencies of Walker '544. Applicant submits that Walker '544 also fails to disclose anything equivalent to the input module and the account processing module as recited in Claim 10.

Furthermore, it would not have been obvious to one of ordinary skill in the art to provide the modules of Claim 10 in view of the combined teachings of Walker '544 and Walker '544, as set forth above with respect to Rejection of Claim 4. Thus, Claim 10 and its dependent claims including Claims 11 and 13 are patentable over Walker '544 and Walker '544.

Discussion of Rejection of Claims 12 under 35 U.S.C. § 103

The Examiner rejected Claim 12 under 35 U.S.C. § 103 (a) as being unpatentable over Walker '544 in view of Manual. Applicant respectfully submits that Claim 12 is patentable over the reference as discussed below.

No Prima Facie Case of Obviousness Has Been Established Against Claim 12

Since Claim 12 depends from Claim 10, if Claim 10 is patentable, Claim 12 is also patentable. Thus, now the patentability of Claim 10 is discussed. Claim 10 is patentable over Walker '544 in view of Manual as discussed below.

As discussed above in connection with the rejection of Claim 10 under §102, Walker '544

fails to teach, among other features of Claim 10, an input module configured to *receive a request for increasing the limit of the financial account based on a gift certificate which has a monetary value*. Walker '544 also fails to disclose an account processing module configured to *increase the limit of the financial account by the monetary value in response to the request*.

Manual does not cure the deficiencies of Walker '544. Applicant submits that Manual also fails to disclose anything equivalent to the input module and the account processing module as recited in Claim 10.

Furthermore, it would not have been obvious to one of ordinary skill in the art to provide the modules of Claim 10 in view of the combined teachings of Walker '544 and Manual, as set forth above with respect to Rejection of Claim 4. Thus, Claim 10 and its dependent claims including Claim 12 are patentable over Walker '544 and Manual.

Further Discussion of Patentability of Dependent Claims

Applicant respectfully submits that pursuant to 35 U.S.C. § 112, ¶4, the dependent claims incorporate by reference all the limitations of the claim to which they refer and include their own patentable features, and are therefore in condition for allowance. Therefore, Applicant respectfully requests the withdrawal of all claim rejections and prompts allowance of the claims.

Application No.: 10/508,942
Filing Date: October 01, 2004


CONCLUSION

In view of Applicant' amendments to the claims and the foregoing remarks, Applicant respectfully submits that the present application is in condition for allowance. Should the Examiner have any remaining concerns, which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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Appendix

REPLACEMENT SHEET

Applicant:	Mi-Sun Sung
Appln. No.:	10/508,942
Filed:	October 01, 2004
For:	SYSTEM AND METHOD FOR OPERATING A GIFT CERTIFICATE ON THE BASIS OF CREDIT CARD TRANSACTIONS